UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: May 31, 2013

Cancellation Nos. 92053610 (parent)
92055259

Strategic Marks, LLC

v.

Conagra Grocery Products Company, LLC

Robert H. Coggins,
Interlocutory Attorney:

These cases come up on petitioner's motion (filed November 30, 2012, in each proceeding) to reopen discovery.[1] Respondent filed a brief in opposition thereto. Before determining the motion to reopen, the Board addresses the issue of consolidation.

Consolidation

It has come to the attention of the Board that Cancellation Nos. 92053610 and 92055259 involve the same

[1] Petitioner's appearance of counsel (filed October 22, 2012, in Cancellation No. 92053610) is noted and entered. The same appearance, filed in Cancellation No. 92055259 was previously noted by the Board. *See* Board order dated October 25, 2012, in Cancellation No. 92055259.

parties and common questions of law and fact. It would therefore be appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a).

Consolidation is discretionary with the Board and may be ordered upon the Board's own initiative. *See, for example*, Wright, Miller, Kane and Marcus, 9A Fed. Prac. and Proc. Civ. §2383 (3d ed. 2012); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991). Accordingly, the above-noted cancellation proceedings are hereby consolidated and may be presented on the same record and briefs. *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989), and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1432 (TTAB 1993).

The Board file will be maintained in Cancellation No. 92053610 as the "parent" case. The parties should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed in the parent case, and each paper should bear the case caption as set forth above.

Motion to Reopen

Discovery closed in (parent) Cancellation No. 92053610 on October 18, 2012, and discovery closed in (child) Cancellation No. 92055259 on November 6, 2012. By way of the outstanding motion, petitioner seeks to reopen the discovery period in each consolidated proceeding. In view

thereof, petitioner must establish that its failure to act in a timely manner (i.e., prior to the close of discovery) was the result of excusable neglect. *See Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1710 (TTAB 2011).

In *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court clarified the meaning and scope of "excusable neglect," as used in the Federal Rules of Civil Procedure and elsewhere. The Court held that the determination of whether a party's neglect is excusable is:

> at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include. . . [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

Pioneer Inv. Servs. Co. v. Brunswick Assocs. L.P., *supra* at 395. In subsequent applications of this test, several courts have stated that the third *Pioneer* factor, namely the reason for the delay and whether it was within the reasonable control of the movant, might be considered the most important factor in a particular case. *See Pumpkin, Ltd.*, *supra* at 1586 n.7 and cases cited therein.

With regard to the first *Pioneer* factor, there does not appear to be any evidence of significant prejudice to respondent. Respondent has not shown that it has lost any evidence, that its witnesses might now be unavailable, or that it would otherwise be handicapped at trial. *See Vital Pharmaceuticals Inc., supra*, 99 USPQ2d at 1710; *citing Pratt v. Philbrook*, 109 F.3d 18, 22 (1st Cir. 1997), and *Paolo Associates Ltd. P'ship v. Bodo*, 21 USPQ2d 1899, 1904 (Comm'r 1990).

With regard to the second *Pioneer* factor, the Board finds that the forty-three-day lapse (from the close of discovery until the motion to reopen was filed) in the parent case is not insignificant. Petitioner filed the motion a mere two days prior to its deadline for pretrial disclosure. Similarly, the twenty-four-day lapse in the child case, when viewed in context with petitioner's appearance of counsel on October 22, 2012 (i.e., fifteen days *before* discovery closed in the child case) shows a continuing lack of attention to that case. This is particularly troublesome since respondent has previously moved to reopen time in the parent case (i.e., by way of its May 24, 2011 motion to set aside judgment in Cancellation No. 92053610) and is therefore well aware of the need to act in a timely manner.

With regard to the third *Pioneer* factor, petitioner characterizes its failure to take discovery in either proceeding as "[d]ue to certain circumstances outside of [p]etitioner's control"; however, the circumstances were wholly within petitioner's control. Petitioner was informed in August 2012 that its former counsel would no longer represent petitioner. It has not gone unnoticed that petitioner failed, in its current motion, to provide the specific date in August that it was so informed; however, even assuming it was the last day of August 2012 (i.e., August 31, 2012), that would have given opposer forty-eight days to act in the parent case and sixty-seven days to act in the child case, before discovery closed, by, for example, filing a motion to extend discovery or to suspend proceedings while petitioner searched for counsel. Petitioner was well aware of the need to act within the time allowed, and has already used, *inter alia*, the excuse in parent proceeding that it was in the process of retaining counsel when it failed to timely act on an earlier motion to dismiss. *See* Board order dated February 10, 2012, in parent Cancellation No. 92053610, granting petitioner's motion for relief from final judgment based on excusable neglect. It is noted that discovery opened in the parent case on April 21, 2012, and opened in the child case on May 10, 2012; and that petitioner, in the motion to reopen, has failed to

provide any explanation why prior counsel did not serve discovery during the period from April 21, 2012 (in the parent case) or May 10, 2012 (in the child case) until August 2012. *See Gaylord Entertainment Co. v. Calvin Gilmore Productions Inc.*, 59 USPQ2d 1369, 1373 (TTAB 2000) (excusable neglect not found where movant failed to provide explanation as to the specific reason for former counsel's inaction). Moreover, petitioner has failed to provide any evidence of or details about its "diligent" search for new counsel after learning that its former counsel would no longer represent petitioner. Petitioner brought these cancellation proceedings and, thus, carries the burden of going forward in a timely manner. *Procyon Pharmaceuticals Inc. v. Procyon Biopharma Inc.*, 61 USPQ2d 1542, 1544 (TTAB 2001). The motion and the exhibits thereto fail to provide a specific date on which petitioner's new counsel was retained. Although respondent raised this issue in the brief in opposition, petitioner failed to file a reply brief to specify the date. Petitioner mentions "October 2012" in Exhibit C to the motion, but fails to provide the actual date on which counsel was retained. While it is clear that new counsel filed its appearance on October 22, 2012, it is unclear how long counsel had been retained before making that appearance. After new counsel for petitioner filed its appearance on October 22, 2012, counsel was informed on

October 25, 2012, in child Cancellation No. 92055259 that "dates remain as previously set." *See* Board order dated October 25, 2012, in Cancellation No. 92055259. Counsel should have acted immediately to extend or suspend dates to obtain the benefit of the lower, good cause standard still available in the child case. The Board finds that petitioner's actions, or lack thereof, were within petitioner's reasonable control and weigh strongly against a finding of excusable neglect.

With regard to the fourth *Pioneer* factor, the Board finds that there is no evidence of bad faith on the part of petitioner.

On balance, and giving appropriate weight to the third *Pioneer* factor, the Board finds that petitioner's failure to act before the close of the discovery period did not result from excusable neglect. Accordingly, petitioner's motion to reopen the discovery period is denied.

Schedule

Discovery is closed. Although proceedings have not been suspended during the pendency of the motion to reopen, the Board exercises its discretion to reset dates for these consolidated cases on the following schedule.

Plaintiff's Pretrial Disclosures	**7/3/2013**
Plaintiff's 30-day Trial Period Ends	**8/17/2013**
Defendant's Pretrial Disclosures	**9/1/2013**

Defendant's 30-day Trial Period Ends	**10/16/2013**
Plaintiff's Rebuttal Disclosures	**10/31/2013**
Plaintiff's 15-day Rebuttal Period Ends	**11/30/2013**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.